



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

0718.0009C

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

Application Number

09/931,187

Filed

08/17/2001, 200

First Named Inventor

Randy Mersdy

Art Unit

3621

Examiner

Worjloh, J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

40,169

Registration number _____

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Stuart B. Shapiro

Signature

Stuart B. Shapiro

Typed or printed name

(301) 424-3640

Telephone number

11/02/2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Attorney Docket No.: 0718.0009C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the PATENT application of

Randy Mersky et al.

Serial No.: 09/931,187

Filed: August 17, 2001

For: Method and Apparatus for Facilitating Manual Payments for Transactions Conducted Over a Network

Examiner: Worjloh, Jalatee

Art Unit: 3621

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request a Pre-Appeal Brief Review of the outstanding issues raised in the Final Office Action of May 10, 2005. Applicants believe there exist clear errors in the Examiner's Final rejections as discussed below.

THE PRESENT INVENTION

The present invention is directed toward a system that enables tender of payment manually (e.g., cash, check, etc.) for transactions conducted over a network (e.g., the Internet). The system includes one or more computer systems each located at a corresponding agent site, one or more merchant systems and a server computer system in communication with the agent and merchant systems. The server system accesses the appropriate merchant network or web site in response to transaction selection information received from the agent system, and translates those web pages for transmission to the agent system. The server computer system further receives the required

transaction information from the agent system and processes the transaction information for transference to the particular merchant web site. In addition, the server system enters credit card information of a provider of the transaction service within the transaction payment information for transference to the merchant system in order to tender payment for the network transaction.

By way of example only, the present invention may enable a user to visit a physical remote site of a service provider and purchase an item from a merchant over the Internet by paying cash to the service provider at that site. The present invention system examines the merchant web site conducting the purchase to determine required information, requests the required information from the user and provides the required information and credit card or other payment information of the service provider to the merchant web site to conduct the transaction. Thus, the transaction may be conducted without a pre-arranged relationship between the user and service provider and without the user having credit cards or even owning a computer system.

FINAL REJECTIONS

The Examiner has rejected claims 1, 2, 6 – 11, 17 – 25, 27 – 31, 35 – 40, 46 – 54 and 57 – 59 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,289,325 (Nakamura et al.) and U.S. Patent Application Publication No. 2001/0044787 (Shwartz et al.) in view of U.S. Patent Application Publication No. 2002/0069166 (Moreau et al.).

The Nakamura et al. patent and Shwartz et al. publication, either alone or in combination, fail to disclose several features within independent claims 1, 22, 30 and 50 as discussed in detail at Pages 20 – 25 of the amendment filed February 10, 2005. Briefly, the Nakamura et al. patent and Shwartz et al. publication do not disclose, teach or suggest at least the features of enabling users to tender payment manually (e.g., cash, check, etc.) at a remote site for transactions conducted over a

network, facilitating performance of the customer selected transaction in response to the manual tender of the customer payment, examining an accessed network site to determine information required by the accessed network site to conduct the customer selected transaction, transmitting an information request to an agent processor (or agent processing means) requesting a portion of the required information, and receiving the customer transaction information from the agent processor (or agent processing means) and transmitting the required information portion and payment information associated with the service provider to a particular provider processing system in order for the service provider to pay for the transaction in response to the manual tender of the customer payment indicated within the received customer transaction information.

The Moreau et al. publication does not compensate for the deficiencies of the Nakamura et al. patent and Shwartz et al. publication. Rather, the Moreau et al. publication discloses a system and method for facilitating buying and selling of products and services, where a merchant offering products or services to customers may provide the customers an option to pay for the products and services at a collection agent selected by the customer. The collection agent forwards the payments to the merchant or facilitator. In one aspect, the merchant offers a product or service via the Internet (e.g., See Abstract). A customer may order a product or service from a web site, where the customer may be presented with payment options (e.g., credit card, cash; See Paragraph 0070). If cash is selected, order information may be transmitted to a facilitator for processing (e.g., See Paragraphs 0071 - 0073). The facilitator presents the customer with a list of collection agents (e.g., See Paragraph 0076 – 0077). The customer visits the selected collection agent to tender payment (e.g., See Paragraphs 0078 and 0081). The collection agent forwards payment to the merchant, preferably by prearranged deposit accounts (e.g., See Paragraph 0082). When the merchant receives payment, the ordered product or service is shipped (e.g., See Paragraph 0083).

Thus, the Moreau et al. publication discloses a customer ordering a product or service over the Internet and paying for the ordered product or service at a selected collection site, where the tendered payment is forwarded to the merchant independent of the merchant web site. In other words, the Moreau et al. system does not complete the transaction for the customer over the merchant web site by determining the appropriate information for the transaction and providing that information, including the service provider payment information, to that web site as recited in the claims. Accordingly, the Moreau et al. publication does not disclose, teach or suggest the features of facilitating performance of the customer selected transaction in response to the manual tender of the customer payment, examining an accessed network site to determine information required by the accessed network site to conduct the customer selected transaction, transmitting an information request to an agent processor (or agent processing means) requesting a portion of the required information, and receiving the customer transaction information from the agent processor (or agent processing means) and transmitting the required information portion and payment information associated with the service provider to a particular provider processing system in order for the service provider to pay for the transaction in response to the manual tender of the customer payment indicated within the received customer transaction information as recited in the independent claims.

The above discussion applies to corresponding dependent claims 2, 6 – 11, 17 – 21, 23 – 25, 27 – 29, 31, 35 – 40, 44, 46 – 49, 51 – 54 and 57 – 59.

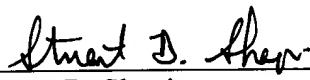
In addition, there is no apparent reason or motivation to combine the teachings of the Nakamura et al. patent and Shwartz et al. publication as discussed at Page 25 of the amendment of February 10, 2005. Further, a similar situation exists with respect to the addition of the Moreau et al. publication. Since the Nakamura et al. patent is directed toward managing communications between software agents within a virtual mall, there is no apparent reason or motivation for one of ordinary

skill to significantly modify the Nakamura et al. system to include specific payment features (e.g., relating to anonymity and tendering of various payment forms).

The Examiner has further rejected claims under 35 U.S.C. §103(a) based on the above combination and further in view of several documents (claims 3, 4, 32 and 33 further in view of U.S. Patent Application Publication No. 2001/0037311 (McCoy et al.); claims 5 and 34 further in view of U.S. Patent Application Publication No. 2003/0167392 (Fransdonk); claims 12, 41 and 55 further in view of U.S. Patent Application Publication No. 2003/0126067 (Seifert et al.); claims 13, 26, 42 and 56 further in view of U.S. Patent Application Publication No. 2003/0069857 (Junda); claims 14, 16, 43 and 45 further in view of U.S. Patent No. 5,983,204 (Debe); and claim 15 further in view of U.S. Patent Application Publication No. 2004/0143600 (Musgrove et al.)). These documents do not compensate for the deficiencies of the Nakamura et al. patent and Schwartz et al. publication as discussed in detail at Pages 25 – 33 of the amendment filed February 10, 2005. Those arguments similarly apply to the addition of the Moreau et al. publication.

In view of the foregoing, Applicants respectfully request withdrawal of the outstanding rejections and allowance of the application.

Respectfully submitted,


Stuart B. Shapiro
Registration No. 40,169

EDELL, SHAPIRO & FINNAN, LLC
1901 Research Boulevard, Suite 400
Rockville, Maryland 20850-3164
(301) 424-3640

Hand-delivered: Nov. 2, 2005